

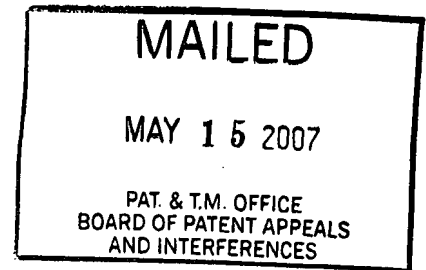
1 RECORD OF ORAL HEARING
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3 UNITED STATES PATENT AND TRADEMARK OFFICE
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6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES
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10 Ex parte KAZUO SHIOTA, SHUICHI OHTSUKA,
11 NOBUYOSHI NAKAJIMA, NORIHISA HANEDA,
12 SUGIO MAKISHIMA, HIROSHI TANAKA,
13 and KAZUHIKO TAKEMURA
14

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16 Appeal 2007-0974
17 Application 08/979,567
18 Technology Center 3600
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21 Oral Hearing Held: April 24, 2007
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25 Before KENNETH W. HAIRSTON, HOWARD B. BLANKENSHIP, and
26 MASHID D. SAADAT, Administrative Patent Judges.
27

28 ON BEHALF OF THE APPELLANTS:
29

30 JOHN R. SANDERS, PATENT AGENT
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35 The above-entitled matter came on for hearing on Tuesday, April 24, 2007,
36 commencing at 9:00 a.m., at The U.S. Patent and Trademark Office, 600
37 Dulany Street, Alexandria, Virginia, before Victoria Gudeman, Notary
38 Public.

1 MR. SANDERS: Good morning, Your Honors. Let me just talk for a
2 few moments about the nature of the invention, and then go into the
3 rejection and the prior art that has been levied against the claims.

4 First, though, the appeal brief is directed to many different groups of
5 claims. However, all of them -- all the claim groups do contain the aspect of
6 the invention that I'm going to discuss today, so I'm going to keep it simple
7 and just direct it to the main feature.

8 If you would, think back to 1997. This is when this case was filed.
9 So it is directed to some technology that may seem commonplace nowadays,
10 digital cameras and -- or digital picture ordering. Back in '97, digital
11 cameras were more on the forefront, more expensive. What we're talking
12 about right now is film ordering, print ordering.

13 The present invention is directed to recording high-resolution picture
14 image data and -- let me back up. I'm sorry. Let me talk about the problem
15 to be solved in this case.

16 First of all, print ordering information in electronic data format is
17 what the prior art at the time of the invention was directed to. We have film
18 service industry where if you have a roll of film, you can get an index file
19 printed of those images after they have been scanned from the film, and
20 electronic ordering can be performed using that index print.

21 This ordering information for a client software, such as application
22 software on a client computer or user computer at home, this order
23 information dictating types of photo finishing to be processed on the image,
24 size of the image, number of prints to be ordered. And this order
25 information used by -- are used by the print services, such as a photo lab
26 development, print enlargement services. And these available printing

1 services tend to vary, depending upon the specific lab that the user is using
2 or time of the year.

3 For example, at certain times of the year, a user might be able to order
4 Christmas cards with images from the film that they have given to the print
5 services. Other times, new services can be rolled out, old ones discontinued.
6 So what we have right now is a roll of film given to a film service that then
7 provides the customer with an index print of -- an index file of the scanned
8 images from the film. And then using that information at a client's home
9 computer, they can then pull up those prints and then order whatever they
10 want.

11 So what happens with the prior art is that since these printing services
12 can change over time, that the prior art did not recognize, well, if a person
13 has gotten this disk or medium with the index print file on there, and then
14 takes it home and then puts it on his computer and is using application
15 software to order prints, that their application software may not have all the
16 updated print services. That can change over time or be seasonal or what-
17 have-you.

18 So the present invention -- and if you'll just look at Claim 1, it's a
19 picture print ordering method which orders a print of a picture image by
20 generating print ordering information comprising electronic data in a
21 predetermined standard to be processed by a predetermined photo finishing
22 system comprising the steps of recording high-resolution picture image data
23 obtained by reading a developed film. That's recording that image data and
24 the printing service information regarding the printing service which can be
25 provided for the picture data, high-resolution picture data. That's recording
26 high-resolution picture image data and printing service information both in

1 the same portable recording medium.

2 So we have the image data recorded from a photographic film. The
3 important thing to see here is the printing service information regarding the
4 printing service which can be provided, that also being in the same portable
5 recording medium.

6 That printing service information is also delineated in the claim as
7 being updateable information for use in generating an updateable order
8 screen displaying available printing services from which a user selects.

9 Further claim limitations deal with displaying this order screen using
10 the printing service information, the updateable information, and then
11 generating print order information, which is the actual order that the user is
12 using for, you know, selecting size, a 4-by-6 print, wallet size. Also
13 specifying service provider at which the printing service information has
14 been recorded in the portable recording medium.

15 So I'll just go ahead and get to the rejection. And the main reference
16 is Moghadam. I don't know if I'm pronouncing that correctly. What I'm to
17 point out here is that the 103 rejection, Moghadam in view of -- I'm not
18 today going to be arguing motivation. I'm not acquiescing to motivation.
19 The core argument in this case is whether or not the references even show all
20 the features of the claim.

21 So Moghadam is directed to network-based print ordering. It involves
22 some of the similar technology. I will say that. What we have is
23 photographic film being sent to or delivered to a print ordering or printing
24 facility, a print service provider. And some of the features of Moghadam
25 which are talked about by the examiner are directed to a magnetic strip
26 which is placed on the film recording information. Now, this may, on the

1 surface, appear to be information that's recorded on a portable medium. The
2 examiner points to the cartridge, the actual film cartridge, as being a portable
3 medium.

4 However, this is actually on the film itself. One of the limitations of
5 the claim is that it's -- we're recording high-resolution picture image data
6 obtained by reading a developed film, so we've read the data off the film.
7 But also more importantly is that the magnetic strip is for recording a
8 customer's address or information regarding the order itself, such as film
9 characteristics of the original film, exposure conditions and the like.

10 Most importantly, this is not printing service information regarding
11 the printing service, which can be provided. This was part of, I believe, the
12 final rejection of our earlier arguments.

13 Characterizing Moghadam, we talk about -- it's directed to a photo
14 finishing system where you can place orders. However -- and I believe it's
15 directed to Figure 4 -- we have a central computer, which is 48 there, at a
16 print service location. And after the print service location has received the
17 film and has scanned the image data off of the film, the photos are stored in
18 the central computer.

19 Now, for ordering purposes, the user, through a home computer,
20 which you can see over there on the right, or a customer-authorized site over
21 there, we have -- it accesses these photos through data link 72 and performs
22 ordering in this way. This is entirely different from having print service
23 information on the same medium, portable recording medium, as required by
24 the claims, on the same medium as this image information, the actual image
25 itself. This is clearly network-based system. Also, Moghadam, in column 5,
26 lines 39 through 46, discusses how the prints can actually be ordered. And if

1 I can just go to it real fast.

2 So for this communication channel 72, customer at a convenient time
3 accesses the data, the digital file available for viewing. Customer can utilize
4 the print screen capability of the home computer, generate a hard copy of the
5 digital index prints, in turn can mark with a pen to indicate the customer
6 selections, including size and quantity. There is no discussion -- the
7 customer can then fax the screen printout to the photo finisher.

8 So what Moghadam doesn't go into is whether or not these ordering
9 options are every updated, for one thing.

10 We can say that since they're operating through a network, whatever
11 it's going to be at the network 48, the central computer, is most likely going
12 to be what's currently available. What the instant invention is dealing with
13 is a system where you have an application on your home computer, and a
14 portable medium that it's not network-based. You drop your film off at a
15 film mart. They give you this index print file on a disk. Associated with
16 that disk is their current updateable print services. If you have a client
17 application at home, that information that is now with the images on the disk
18 can then give you an updated service list on your home computer.

19 Now, in the --

20 JUDGE SAADAT: Excuse me, sir.

21 MR. SANDERS: Yes, please.

22 JUDGE SAADAT: You're suggesting that Moghadam has all the
23 services or information about the print service in the distributed system.

24 MR. SANDERS: It does not say -- it does appear -- I'm sorry. Can
25 you repeat that?

26 JUDGE SAADAT: The printing services that the reference provides,

1 like information about the quality, the print number, and all that, is that
2 considered printing service information the same way claim requires?

3 MR. SANDERS: The claim -- print service information at the bottom
4 of the claim includes the qualify of attributes, including size and kind, and
5 name of an apparatus and/or service provider. So I would say that it's
6 comparable.

7 JUDGE SAADAT: And it is available -- you're accessing a network
8 or a server.

9 MR. SANDERS: The reference doesn't really go into that.
10 Moghadam talks about viewing the digital index prints, using the print
11 screen to generate a copy of the prints. There is also Figure 5 of Moghadam
12 is what Moghadam discusses as the ordering system, or the ordering
13 information. This is over the network.

14 We have sizes, selection of individual sizes. This is in column 6 in
15 the first paragraph. Kind? I'm not really sure how much figure 5 shows
16 besides ordering sizes of specific prints. There's no discussion of post-
17 processing or the service provider itself. We have his address.

18 We can get back to that. If I could move on to maybe some more
19 distinguishable features.

20 JUDGE SAADAT: Sure.

21 MR. SANDERS: Okay. Once again, though, things that might seem
22 commonplace now, we've got to think back in '97 where cameras don't even
23 have digital cameras within -- I mean cell phones don't have digital cameras.
24 Most people don't have a digital camera. On line ordering of prints is being
25 used from primarily film-based stuff.

26 But let me talk about what the examiner talks about in his examiner's

1 answer, and what issues that he felt Moghadam -- or what limitations he
2 believed Moghadam was showing. Then the examiner's answer, we are
3 talking about a CD ROM that is disclosed by Moghadam. Moghadam at
4 least contemplates the use of a CD ROM to transmit the digital image index
5 file.

6 And let me just say again that the primary feature of the claims is
7 putting the photo -- the printing service information regarding the printing
8 service which can be provided on the same medium as the high-resolution
9 picture image data. But also, that printing service information is updateable
10 information for use in generating an updateable order screen displaying
11 available printing services from which the user selects.

12 The examiner points to Figure 5 as showing updateable print service
13 information. There is no disclosure that this information is stored on this
14 disk, on the medium with the image data. He tends to say that it actually is -
15 - if I can just take a look at the actual -- he doesn't even go into that. He's
16 more focused on whether or not the data is actually displayed to the user.

17 So what we have is Moghadam not disclosing that this updateable
18 service information is actually on the disk. And if we don't have that in the
19 reference, at least in this rejection, he's relying on it to show that, and it's
20 not there.

21 He goes into detail about the actual order screen, and showing this in
22 Moghadam. I guess there's some discussion about how it's updateable
23 information.

24 Even if this information -- print service information was stored on the
25 data -- on the disk with the image, Moghadam actually doesn't discuss that.
26 Nowhere in Moghadam does it discuss it being updateable information.

1 Nowhere does Moghadam discuss keeping the print services current, or that
2 they are in some way related to an updateable information system. Also,
3 perhaps size and kind are shown in Moghadam. All I really see there is size.
4 But it also requires at least the name of an apparatus or a service provider by
5 which the printing service information has been recorded.

6 And with the secondary reference, Farrose, the examiner has gone and
7 used that to show the order screen and just a layout of the order screen in a
8 comparable embodiment remote printing ordering. But there's still no
9 discussion about actually having an updateable print service information on
10 the disk itself. That's the key point that we should --

11 JUDGE HAIRSTON: Your 20 minutes is about up. Can I get you to
12 sum up? Is that your whole argument?

13 MR. SANDERS: Key point is Moghadam is directed to a network-
14 based system. We're not talking about a portable recording medium.
15 Moghadam does not discuss with any particularity the actual print services
16 that are being offered, beyond size, and maybe a type or layout. It doesn't
17 discuss whether or not these things are updateable or not.

18 But the actual placement of this print services information on the disk
19 with the image data is what is enabling this invention to have a user
20 application that is going to reflect the most recent and updated available
21 print services such that, you know, a user cannot place an order for
22 something that's no longer available and create a problem that way, or the
23 user not be aware of all the print service options that are available to him.

24 I think the focus is a little bit more on -- the rejection is more on --
25 originally was on the order screen. And then at some point in the examiner's
26 answer, the examiner introduced some further arguments regarding

1 characterizations of Moghadam, which we frankly don't agree with,
2 especially with respect to the CD ROM. There's a CD ROM contemplated.
3 The only thing mentioned as being on the CD ROM is the print index file
4 itself.

5 JUDGE HAIRSTON: Any questions?

6 JUDGE SAADAT: We have no more.

7 JUDGE HAIRSTON: Thank you.

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9 (Whereupon, the proceedings concluded.)